

ESTTA Tracking number: **ESTTA598206**

Filing date: **04/11/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206915
Party	Plaintiff mybody, L.L.C.
Correspondence Address	MICHAEL D HOOL HOOL LAW GROUP PLLC 2398 E CAMELBACK RD STE 1020 PHOENIX, AZ 85016 UNITED STATES uspto@hoollawgroup.com
Submission	Reply in Support of Motion
Filer's Name	Michael D. Hool
Filer's e-mail	uspto@hoollawgroup.com, uspto@hoolcourylaw.com
Signature	/Michael D. Hool/
Date	04/11/2014
Attachments	Opposer's Reply Brief in Support of MJS.pdf(142210 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No.: 85/597,114
Published in the Official Gazette on August 28, 2012

MYBODY, L.L.C.

Opposer,

vs.

ERIC LUCAS

Applicant.

Opposition No.: 91206915

**OPPOSER'S REPLY BRIEF IN
SUPPORT OF ITS MOTION
FOR SUMMARY JUDGMENT**

Opposer, MyBody, L.L.C. ("mybody"), by and through its counsel, hereby files this reply brief in support of its Motion for Summary Judgment:

I. INTRODUCTION

Opposer remains entitled to summary judgment despite Applicant's attempts to create the illusion that issues of material fact exist. Applicant's Response ignores the record, distorts Opposer's mark, and attempts to unilaterally re-classify Opposer's products, serving no purpose but to cause further undue delay in resolving this dispute. There is no genuine issue of material fact in dispute with regards to priority as the initial date and scope of use are admitted by the parties' in their respective discovery documents and cited in Opposer's Motion for Summary Judgment. Moreover, it appears as though Applicant is arguing against a mark other than Opposer's, apparently for the sole purpose of making Applicant's MY HERO mark seem different than Opposer's MYHERO mark. Applicant incorrectly refers to the MY HERO mark be applied for as a "pink" logo and,

therefore, unlikely to be confused with Applicant's MY HERO. To the contrary, the record clearly shows that the nearly identical marks consist of standard characters without any claim to font, style, size, or color. Lastly, Applicant contends that Opposer's skin cream is "really a medicinal treatment" by citing two obscure Federal Drug Administration import alerts, neither of which have any bearing whatsoever upon Opposer's products, marks, or these proceedings. Applicant appears to be making this logical leap to then argue that Applicant's skin lotion is materially different than Opposer's skin cream.

Applicant has failed to raise any genuine issue of material fact that can be disputed as to priority or likelihood of confusion. As such, Opposer is entitled to summary judgment as a matter of law.

II. FACTUAL BACKGROUND

The introductory matters are fully set forth in Opposer's Motion for Summary Judgment, filed on February 20, 2014.

III. ARGUMENT

a. Applicant has failed to establish the existence of any genuine issue of material fact as to priority.

Applicant has not raised any genuine issue of material fact regarding priority and Opposer's documented prior use remains sufficient. The petitioner must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods. *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989). A showing of analogous use does not require

direct proof of an association in the public mind. *T.A.B.Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1375, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). The activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in the mark. *Id.*

The record clearly demonstrates Opposer's prior use as Opposer had been using the MYHERO mark on its products, both nationally and internationally, for over fifteen (15) months, beginning on January 28, 2011, before Applicant filed his MY HERO application (Serial No. 85/597,114), based upon an intent to use the mark, on April 13, 2012. [Opposer's SoF MSJ ¶ 2,5].¹ Pursuant to Applicant's request, Opposer has previously disclosed selling thousands of units in thirty-two (32) states and numerous other countries from January of 2011 to February of 2013. [Opposer's R INT 1 ¶ 4(a)].² Such use was sufficient to create an association in the purchasing public as Opposer expended considerable time and capital to advertise and sell products related to Opposer's MYHERO mark. [Opposer's SoF MSJ ¶ 3]. It is certainly reasonable to conclude that a well-funded and coordinated marketing campaign associated with Opposer's mark, in addition to thousands of domestic and international sales, would have a substantial impact upon the purchasing public. Applicant has not raised a single genuine issue of material fact with regards to establishing priority.

b. There is no genuine issue of material fact that Applicant's MY HERO mark and Opposer's MYHERO mark are virtually identical.

¹ Refers to Opposer's Statement of Material Facts and Exhibits Supporting Motion for Summary Judgment, filed on February 20, 2014 contemporaneously with Opposer's Motion for Summary Judgment.

² Refers to Opposer's Response to Applicant's Interrogatories to Opposer (Set 1) Response 4(a) (Redacted version attached hereto as Exhibit A. Unredacted version submitted to Applicant on February 20, 2013, Bates number MYB000001, pursuant to Stipulated Protective Order filed on February 12, 2013).

While Applicant is correct that the likelihood of confusion analysis turns on all of the probative facts in evidence that are relevant to the *DuPont* factors, Applicant fails to acknowledge the progeny of that case. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *see also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Implicit in that statement is the understanding that any number of factors, save those two, might not be a part of the analysis. The similarity of the marks and the similarities of the goods and services are particularly relevant in the present case as Applicant had not actually used his mark in commerce prior to the commencement of these proceedings, thereby making a good portion of the DuPont analysis impractical. [Opposer's SoF MSJ ¶ 6].

Based upon the evidence produced, all of the *available and relevant* factors weigh in favor of finding a likelihood of confusion between Applicant's MY HERO mark and Opposer's MYHERO mark. Applicant has failed to raise any genuine issue of material fact with regards to likelihood of confusion. Despite Applicant's misleading claim that Opposer's mark is simply a "pink logo," both marks consist of standard characters without any claim to font, style, size, or color. [Opposer's SoF MSJ Exh. A,C]³.

Applicant's claim that his MY HERO mark is not confusingly similar to Opposer's

³ Refers to the exhibits that accompanied Opposer's Statement of Material Facts and Exhibits Supporting Motion for Summary Judgment, filed on February 20, 2014 contemporaneously with Opposer's Motion for Summary Judgment.

MYHERO mark requires a total departure from common sense. The only difference between the two is one character space between the words. Courts have found that a space between words in a mark is hardly enough to create a distinct commercial impression or distinguish two marks. *See Stock Pot, Inc. v. Stockpot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983) (“There is no question that the marks of the parties ‘STOCKPOT’ and ‘STOCK POT’ are confusingly similar. The word marks are phonetically identical and visually almost identical.”) All of the authorities cited in Applicant’s Response are easily distinguished as cases where whole words between the two marks were either different or omitted. *Cf. Conde Nast Publications, Inc., v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975); *Cf. In re Ferrero*, 479 F.2d 1395, 1397 (CCPA 1973); *Cf. Plus Products v. General Mills, Inc.*, 188 USPQ 520, 522 (TTAB 1975).

The evidence establishes that there is no genuine issue of material fact regarding likelihood of confusion as the parties’ marks are virtually identical and confusingly similar. As was stated in Opposer’s Motion for Summary Judgment, the goods associated with the marks are highly related and are likely to flow through identical trade channels to the same pool of consumers.

c. Applicant has raised no genuine issue of material fact that Opposer’s MYHERO mark is properly classified.

The second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the goods or services “as described in an application or registration.” *In re Dixie Restaurants Inc.*, 105 F.3d 1407, 41 USPQ2d 1531 (Fed. Cir. 1997).

Applicant's attempt at re-classifying of Opposer's skin cream as "medicinal" is a thinly veiled collateral attack on likelihood of confusion and does nothing to raise a genuine issue of material fact. Id. Opposer has filed an application in Class 003 (Serial No. 85695722) and Opposer's application for the MYHERO mark is dispositive as to placement therein. [Opposer's SoF MSJ Exh A.]. Opposer sells multiple products, including skin creams appropriate for Class 003 which bear Opposer's MYHERO mark. [Opposer's SoF MSJ ¶ 2]. Applicant claimed Class 003 in his MY HERO application (Serial No. 85597114) for "cosmetic preparations." [Opposer's SoF MSJ Exh. C]. During discovery, however, Applicant stated he intended to use the MY HERO mark in connection with the sale of "lotions." [Opposer's SoF MSJ ¶7]. Unlike Applicant, who has claimed both cosmetic preparations and lotions, Opposer's application actually claims the Class 003 skin creams sold under the MYHERO mark. Regardless of whether Applicant is selling cosmetic preparations or lotions, it is clear that the product would share Class 003 with Opposer's skin cream.

While it would be convenient for Applicant to re-classify Opposer's mark for the purposes of trying to create dissimilarity between the two marks, Applicant has offered not one shred of evidence that Opposer's skin cream is a "new drug" aside from pointing out that topical drugs exist. Even if Applicant could prove as much (and it is clear that he cannot), Opposer's application claims Class 003 and Opposer's products have been marketed and sold accordingly.

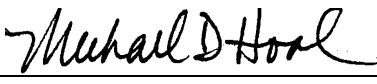
IV. CONCLUSION.

For the reasons stated above, Opposer respectfully requests that the Board grant Opposer's motion for summary judgment. Applicant has failed to raise any genuine issue of material fact which disputes Opposer's showing that Opposer's MYHERO mark has priority and that there is a strong likelihood of confusion between that mark and Applicant's MY HERO mark. Therefore Opposer remains entitled to summary judgment.

Respectfully submitted,

Attorneys for MyBody, LLC

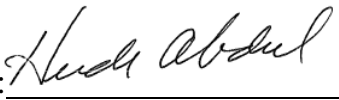
Dated: April 11, 2014.

By: 
Michael D. Hool
HOOL LAW GROUP, PLC
2398 East Camelback Road, Suite
1020
Phoenix, Arizona 85016
(602) 852-5580

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 11th day of April, 2014, a true and correct copy of Opposer's Reply Brief in Support of its Motion for Summary Judgment was deposited with the United States Postal Service, as first class mail, postage prepaid to:

Damon L. Ward
Ward Law Group
301 Fourth Avenue S
378 Grain Exchange Bldg
Minneapolis, MN 55415-1015

By: 

Heidi Abdul
Paralegal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No.: 85/597,114
Published in the Official Gazette on August 28, 2012

MYBODY, L.L.C.
Opposer,
vs.
eric lucas

Applicant.

Opposition No.: 91206915

**DECLARATION TO OPPOSER'S
REPLY BRIEF IN SUPPORT OF ITS
MOTION FOR SUMMARY
JUDGMENT**

STATE OF ARIZONA)
)
COUNTY OF MARICOPA)

I, Michael D. Hool, declare as follows:

1. I am the attorney for Opposer, and I am personally familiar with the pleadings filed in this opposition.
2. Attached hereto as Exhibit A is a true and correct redacted copy of Response Number 4(a) to Opposer's Response to Applicant's Interrogatories to Opposer (Set 1) submitted to Applicant on February 20, 2013, Bates number MYB000001, pursuant to Stipulated Protective Order filed on February 12, 2013.

Pursuant to 28 U.S. Code § 1746, I declare under penalty of perjury under the laws of the United States of American that the foregoing is true and correct.

Executed on April 11, 2014.



Michael D. Hool

myHero Sales summary (1/1/2011 thru 2/18/2013)MYB000001